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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TODD, GREGORY G

ART UNIT PAPER NUMBER

2157

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/907,899

Applicant(s)

GLEDJE, TROND

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/22/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first office action in response to application filed, with the above serial number, on 19 July 2001 in which claims 1-17 are presented for examination. Claims 1-17 are therefore pending in the application.

Claim Objections

1. Claims 5 and 13 are objected to because of the following informalities: The word "preferentials" should be considered to be changed to preferences. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "the tags" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2157

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by

Owensby (hereinafter "Owensby", 6,647,257).

Owensby teaches the invention as claimed including location based mobile advertising (see abstract).

As per Claim 1, Owensby teaches a system for providing advertisements to mobile stations comprising:

a service provider, wherein the service provider includes an information gateway and a service gateway (mobile switching center) (at least Fig. 1-2; col. 14, lines 3-38);

a content provider for providing an advertisement to the service provider (Ad chooser server) (at least col. 14, lines 23-38, 55-62); and

a mobile station (wireless mobile terminal) (at least col. 14, lines 3-16; Fig. 1), wherein the service provider receives information associated with the mobile station from a mobile network (subscriber profile data associated with mobile terminal) (at least col. 15, lines 32-67), and

wherein the mobile station receives the advertisement if the mobile station satisfies a predetermined condition associated with the advertisement (predetermined criteria of Ad target data) (at least col. 16, lines 3-21).

As per Claim 2. The system of claim 1, wherein the predetermined condition is setting up a call or entering a predetermined location (wireless mobile location being predetermined criteria) (at least col. 16, lines 3-21).

As per Claim 3. The system of claim 1, wherein the service gateway receives information associated with the mobile station from the mobile network and wherein the information gateway provides the advertisement to the mobile station under the control of the service gateway (at least col. 16, lines 3-20; col. 14, lines 3-38).

As per Claim 4. The system of claim 1, wherein the content provider provides the advertisement to the service provider tagged with certain information (ad target data) (at least col. 15, lines 32-67; col. 16, lines 22-52).

As per Claim 5. The system of claim 4, wherein the tags are selected from the group consisting of:

information type;

zone/area related information;

information attributes;

information validity;

preferentials; and

language keys (profile data including personal preference data for advertisers to target to a subscriber) (at least col. 15, lines 32-67).

As per Claim 6. The system of claim 1, wherein the service provider is a mobile Internet service provider (wireless Internet) (at least col. 11, lines 51-67).

As per Claim 7. The system of claim 1, wherein the service provider stores information related to the mobile station (data associated with subscriber collected upon initial registration) (at least col. 15, lines 32-67).

As per Claim 8. The system of claim 7, wherein the information related to the mobile station is selected from the group consisting of:

- capability of the mobile station;

- type of connection associated with the mobile station;

- information type;

- information profile;

- language keys; and

whether the mobile station has activated receipt of advertisements (Subscriber profile data including personal preference data and demographic data) (at least col. 15, lines 32-67).

As per Claim 9. The system of claim 1, wherein the mobile station receives the advertisement only if subscriber specific information associated with the mobile station and the capabilities of the mobile station match criteria associated with the advertisement (at least col. 15 line 32 - col. 16 line 20).

As per Claim 10, Owensby teaches a method for providing advertisements to a mobile station in a mobile network comprising the steps of:

- soliciting, by a service provider, content providers (call management server choosing messages) (at least col. 13, lines 15-36);

providing an advertisement, by a content provider, to the service provider, wherein the advertisement includes information associated with the advertisement (ad target data) (at least col. 16, lines 22-50);

soliciting, by the service provider, subscribers with mobile stations (subscriber wishing to receive ad-based subsidy) (at least col. 18, lines 58-67); and

sending the advertisement to the mobile station if the mobile station satisfies a predetermined condition associated with the advertisement (at least col. 16, lines 3-20).

As per Claim 12. The method of claim 10, wherein the service provider includes a service gateway and an information gateway (mobile switching center) (at least Fig. 1-2; col. 14, lines 3-38), the method further comprising the steps of:

receiving, by the service gateway, information associated with the mobile station from the mobile network (subscriber profile data associated with mobile terminal) (at least col. 15, lines 32-67); and

controlling, by the service gateway, the provision of the advertisement (predetermined criteria of Ad target data) (at least col. 16, lines 3-21).

Claims 11 and 13-17 do not add or define any additional limitations over claims 2 and 5-9 and therefore are rejected for similar reasons.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bolduc et al, Hymel et al, Fan et al, Dowling et al, Kinnunen et al, Stewart, Hidary, Boyd, Host et al, Tuttlebee et al, Nihei, and Boyle et al are cited for


disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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